

Appl. No. 10/773,525 Amdt. dated Reply to Office action of November 3, 2006

**Amendments to the Drawings:**

The attached sheets of drawings includes changes to Fig. 5, 5C and 5D. These sheets, which includes Figs. 5A, 5B and 5C, replace the original sheets including Figs. 5, 5c and 5d.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

In the specification, the Brief Description of the Drawings at page 14 has been amended to reflect the renumbering of Figs. 5, 5c and 5d.

In the drawings, Figures 5, 5C and 5D have been amended to be identified as Figures 5A, 5B and 5C respectively to comply with the requirements of 37 CFR 1.84.

Claims 1-20 remain in this application.

Claim 3, 9-12 and 18 have been withdrawn as the result of an earlier restriction requirement.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 3, 9-12 and 18 in a divisional application.

In response to the Office Action of November 3, 2006, Applicant requests re-examination and reconsideration of this application for patent pursuant to 35 U.S.C. 132.

**Election of Species**

The Examiner had required an election of species between the following groups of inventions on October 30, 2006.

Group I was identified as claims 4-7 and 20 and Group II was identified as claims 3, 9, 10 and 18. The reason for requiring an election was that Group I identified the storage container cover as

being a rigid plate and Group II identified the storage container cover being a flexible sheet. Claim 8 depends from claim 7 and therefore should be included in Group I. Claim 11 depends from claim 9 and claim 12 depends from claim 11 and therefore should be included in Group II.

A telephone call was placed on October 30, 2006, to Applicant's representative Mr. Keith Campbell who provisionally elected the Group I species. This election is confirmed herein. Applicant provisionally elects the species of Group I, claims 4-8 and 20 with traverse. Claims 1, 2, 13-17 and 19 are considered to be generic.

37 CFR 1.146 states that "In the first action on an application containing a generic claim to a generic invention and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable (emphasis added). The Examiner has not stated that the two species were patentably distinct, as required by the law, nor provided any evidence to prove that they are patentably distinct.

Applicant respectfully requests that the election of species requirement of claim 1-20 be withdrawn and all the claims examined.

**Rejection under 35 USC 103(a)**

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi et al. (U.S. 5,072,983) in view of Forbes, Jr. (U.S. 4,017,055) and Franks (U.S. 5,513,580). The Examiner alleges that Muroi et al. disclose a back panel member having a back surface, opposite sides, a top and bottom, wherein the sides, top and bottom are substantially perpendicular to the back surface, Muroi et al. also disclose a front panel member having a front surface, opposite sides, a top and bottom and wherein the storage compartment is at least partially recessed within the interior portion of the vehicle door and the storage compartment providing enhanced interior storage for the vehicle.

The Examiner recognizes that Muroi et al. fail to disclose a center member as claimed including opposite sides, a top and bottom for connecting peripheral portions of the front and back panel members so that the front and back panel members face each other to form an interior portion of the storage compartment and wherein the back member is constructed and arranged to telescope inwardly and outwardly within the center member. The Examiner relies on Forbes, Jr. to teach a center member (31) constructed and arranged to engage within and upon the surface of the inner panel (Fig. 1), the center member also has opposite sides for the purpose of providing

adequate anchoring. The Examiner then concludes that it would have been obvious to construct and arrange the center member for engagement with and upon the surface of the inner panel and the center member having opposite sides as taught by Forbes, Jr. Also, the dynamic storage compartment is adapted for insertion within and upon the interior panel of the vehicle door of Muroi et al. in order to enhance anchoring.

The Examiner further recognizes that Muroi et al. does not disclose a front surface of a front panel having an aperture therethrough; a top and a bottom connecting the peripheral portions of the front and back panel members so that the panel members face each other to form front and back inner boundaries of the interior portion of the storage compartment, and wherein the sides, top and bottom of the back member are constructed and arranged to telescope inwardly and outwardly within the center member. The Examiner alleges that Franks teaches a front surface (20) having apertures (34) therethrough(See Figure 1); the center member (100) has opposite sides, the top and the bottom connect the peripheral portions of the front(20) and back (40) panel members so that the panel members (20 & 40) face each other to form front (20) and back (20) inner boundaries of the interior portion of the storage compartment (10) wherein the sides , top and bottom of the back member (40) are constructed and arranged to telescope inward and

outwardly within the center member (100) for the purpose of providing adequate flexibility. The Examiner then concludes that it would have been obvious to provide Muroi et al. with these elements in order to enhance flexibility.

In order to establish a *prima facie* case of obviousness, three basic criteria must be present (MPEP 2142). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references (when combined) must teach or suggest all of the limitations of the claims.

The patent to Muroi et al. teaches a pocket in the door of an automobile and an armrest. The armrest is pivotable between a normal operative position, as illustrated in Fig. 4, and an inclined open position, illustrated in Fig. 1, which permits an article to be placed in the pocket of the door. The armrest is the only element which moves and only in a pivotable manner. Forbes, Jr. discloses a toner dispenser for a xerographic machine. These devices have no relationship what so ever to storage compartments in vehicles. Corrugated strips 41 and 42, positioned on closure element 40, engage corrugated strips 50 and 47 respectively, positioned in opening 46, to control the amount of toner that is

dispensed from dispenser 20. The vertical movement of closure 40 controls the amount of toner released from the dispenser. The vertical position of element 40 is controlled by bolts 33 extending through slots 32 in elements 31 and engaging rods 44 which extend into tube 40. Whenever the position of closure 40 is to be changed the bolts 33 are loosened, the closure 40 moved and the bolts are then tightened again. The purpose of element 31 is to maintain the closure 40 in a fixed position relative to the toner dispenser and thereby control the amount of toner being dispensed.

Applicant fails to see how "the center member (31) of Forbes, Jr. engages with and upon the surface of the inner panel (See Figure 1)" as alleged by the Examiner. What element does the Examiner consider the "inner panel" to be? The Examiner also states that "the center member (31) having opposite sides (See Figure 1) for the purpose of providing adequate anchoring." What element is being anchored and where is it being anchored to? The combination of elements proposed by the Examiner would not yield the claimed invention since it is not clear what the elements are that the Examiner is relying on and how they are being combined. Therefore there would not be a reasonable expectation of success as required to establish a *prima facie* case of obviousness. In addition, why would someone skilled in the automotive art look to a toner dispenser for a xerographic copying machine to modify a storage

compartment in the door of an automobile? Forbes, Jr. provides no motivation to modify Muroi et al. as suggested by the Examiner. Therefore, there is no suggestion or motivation, either in the references themselves or in the knowledge available to one of ordinary skill in the art, to modify the references as required to establish a *prima facie* case of obviousness.

Franks discloses a lockbox or safe which can be installed in a closet in a manner that requires the lockbox to be opened before it can be removed from the closet. The sidewalls 20 and 40 extend outwardly and inwardly from the center assembly 100. They are held in place by locking pins 166 which extend through holes 164 in the center assembly and holes 34 and 54 in the side walls. After the lockbox is placed in a closet the sidewalls are extended until they contact the walls of the closet. They are then locked in place utilizing the locking pins and the door of the lockbox is closed and locked. The lockbox cannot be removed from the closet without first opening the door and removing the locking pins. It is not seen how this lockbox could physically be placed in the door pocket of Muroi et al. as suggested by the Examiner.

Also, Franks does not teach all of the limitations of claim 1, specifically, the front surface of the front panel has an aperture therethrough. The front surface of sidewall 20 of Franks is solid. The apertures are in the sides of the sidewall. Claim 1 also



requires the center member to be "constructed and arranged for mechanical engagement within and upon a surface on an inner panel of a vehicle door". There is no teaching in Franks and none has been provided by the Examiner of how the center assembly 100 of Franks would engage the inner panel of Muroi et al.? Therefore the references (when combined) do not teach or suggest all of the limitations of the claims as required to establish a *prima facie* case of obviousness.

Claims 2, 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi et al., Forbes, Jr. and Franks as applied to claim 1 and further in view of Royer (U.S. Patent Publication No. 2004/0000798). The Examiner alleges that Muroi et al., as modified, does not disclose the front panel member including a covering means movable between a first open position and a second closed position, wherein the covering means is juxtaposed to the aperture while in the closed position.

The Examiner alleges that it would have been obvious to make the front panel, armrest 17 of Muroi et al., movable between a first open position and a second closed position as taught by the tarpaulin 52 of Royer. Applicant fails to see how this is possible.

Regarding claim 4, the Examiner alleges that the covering of Royer includes a rigid plate 74 connected to the front member for pivotal movement between an open and closed position. However, as

illustrated in Fig. 11 of Royer fastening element 74 is secured to a sidewall and does not pivot.

Regarding claim 5, the Examiner alleges that the covering means (52) includes a plurality of narrow elongated rigid elements (74) flexibly connected in an adjacent relationship (Figure 10). However, element 74 is a fastening element and is secured to a sidewall, as illustrated in Figs. 9 & 11. Figure 10 of Royer illustrates a sprocket wheel 65 on the end of rod 54. There are no narrow elongated rigid elements. Hence, Royer does not teach or disclose all the limitations of the claims as required to establish a *prima facie* case of obviousness.

Claims 6, 7 and 11 stand rejected as unpatentable over Muroi et al., Forbes, Jr., Franks and Royer as applied to claim 5 further in view of Adams (U.S. 4,717,196). The Examiner alleges that Adams discloses a plurality of elongated rigid elements constructed and arranged to form a plurality of accordion-like folds, the terminal fold is connected to the front panel member. Also, the plurality of elongated rigid elements are wound around an axle in a series of concentric loops.

The invention disclosed by Adams is a flexible cover for a pick-up truck bed. The cover is formed from a plurality of panels 34 which are connected to each other by hinges 36. As can clearly be seen in Figs. 1 and 4-7 the panels can pivot with respect to

each other but never form any folds. There is no disclosure in Adams that the panels 34 are or can be folded.

Applicant therefore fails to see how Adams discloses all the claim limitations.

Claims 11 and 12 depend from claim 9, which is readable on the non-elected invention of Group II. Therefore, as stated supra, claims 11 and 12 should be included with the claims drawn to the non-elected invention and not examined on their merits at this time.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi et al., Forbes, Jr., Franks, Royer and Adams as applied to claim 7 and further in view of McKeon (U.S. 4,138,154).

While Applicant agrees that McKeon teaches a spring retraction mechanism to retract and deploy a covering, claim 8 depends from claim 7. The rejection of claim 7 is improper as explained supra.

Claims 13-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi et al., Forbes, Jr., and Franks as applied to claim 1 further in view of Levy (U.S. 6,648,166).

Regarding claim 13, the Examiner alleges that element 28 of Levy comprises a means to press a back panel member (16) outwardly of the center member (12). However, a reading of Levy reveals that element 28 is a locking assembly which holds back panel member 16

onto center member 12, the opposite of what is claimed. Therefore Levy does not disclose all the limitations of the claims.

Regarding claim 14, the Examiner alleges that it would have been an obvious matter of design choice to make the means to press the back panel of Muroi et al. outwardly to include at least one spring member because Applicant has not disclosed that the means to press the back panel member outwardly including at least one spring solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a latch.

The problem solved by providing the back panel member with a spring to press the panel outwardly is returning the back panel to its original position prior to being displaced inwardly by lowering the door window. This can be found in Applicant's specification starting at page 17, line 5 and continuing through page 18, line 6. Further, if a latch was employed the back panel member would not be able to move.

Regarding claim 15, the Examiner alleges that Muroi et al. disclose the vehicle door window cooperating with the back panel member to press the back panel member into the center member during downward movement. No discussion of this can be found in Muroi et al. If the examiner continues to maintain this rejection it is requested that he specifically point out in Muroi et al. where this teaching can be found.

Regarding claim 16, the Examiner alleges that it would have been an obvious matter of design choice to make the ramping surface extend between the top and the back surfaces since Applicant has not disclosed that extending the ramping surface between the top and back surfaces solves any stated problem or is for any purpose and that the invention would perform equally well with a linear surface extending between the top and back surfaces.

The problem solved by this construction is that the ramping surface 36 provides for inward movement of the back panel member permits the door window to be lowered. This is clearly illustrated in Fig. 4 and disclosed in the specification at page 17, from lines 13 to 23. If a linear surface were to be employed, as suggested by the Examiner, the back panel would not move inwardly and the window could not be lowered.

Regarding claim 17, the Examiner alleges that Franks teaches providing a front panel arranged to telescope inwardly and outwardly within the center member to provide adjustability and flexibility. As stated previously, in the rebuttal to the rejection of claim 1, it is not seen how the lockbox of Franks could be physically combined with the door pocket of Muroi et al.

Therefore none of the references taken alone or combined as suggested by the Examiner teach all of the limitations of claims 13-17 as required to establish a *prima facie* case of obviousness.

Claims 19 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi et al., Franks, Royer, and Adams and further in view of Levy. The Examiner alleges that Muroi et al., Franks, Royer and Adams together disclose the invention as claimed but do not disclose the lid member hingedly secured to the front panel member and movable between a first open position and a second closed position. The Examiner relies on Levy to teach a lid member as claimed and refers to Figures 1-5 for a teaching. Applicant has examined Figures 1-5 of Levy and cannot determine which elements the examiner is relying on to support his position. Further, the keyhole aperture in the lid member has not been addressed or identified in any of the references. It is requested that the specific elements relied on in Levy be identified to support the Examiner's position. As a result it is not seen that Levy teaches or discloses the lid member as claimed.

Regarding the rejection of claim 20 the Examiner states that:

    "Regarding claim 20, Muroi et al., modified by Franks, Royer and Adams discloses the invention substantially as claimed. Claim 20 is the combination of previous stated claims in this office action with the added feature limitation of the member rigid covering element secured to the front panel member and movably between the first open position and the second closed position, wherein the covering element is juxtaposed to the aperture while in the closed position. All previous stated claims were rejected. Therefore, claim 20 is rejected using the same prior art references on record stated above in combination

that satisfy all relevant limitations recited in claim 20.


Applicant does not understand how the prior art references are being applied in this rejection. If Muroi et al., Franks, Royer and Adams do not teach "the rigid covering element secured to the front panel member and movable between a first open position and a second closed position", as admitted by the Examiner in the rejection, then what prior art reference provides this teaching? If the Examiner is going to maintain this rejection then it is requested that he state which prior art references are being relied on for which specific teachings, what teachings the references are lacking, which references are being relied on to provide these teachings and how the references are being modified to provide all the limitations of the claim as required by 35 U.S.C. 103.

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness, as demonstrated above, and further contend that a person of ordinary skill in the art, having the references Muroi et al., Forbes, Jr., Franks, Royer, Adams, and Levy before them, would not have the information nor the motivation necessary to combine these disclosures to arrive at Applicant's invention. Reconsideration and withdrawal of the Examiner's rejections under 35 U.S.C. 103(a) and allowance of the claims is respectfully requested.

SUMMARY


In light of the foregoing remarks and amendment to the claims, it is respectfully submitted that the Examiner will now find the claims of the application allowable. Favorable reconsideration of the application is courteously requested.

Respectfully submitted,

  
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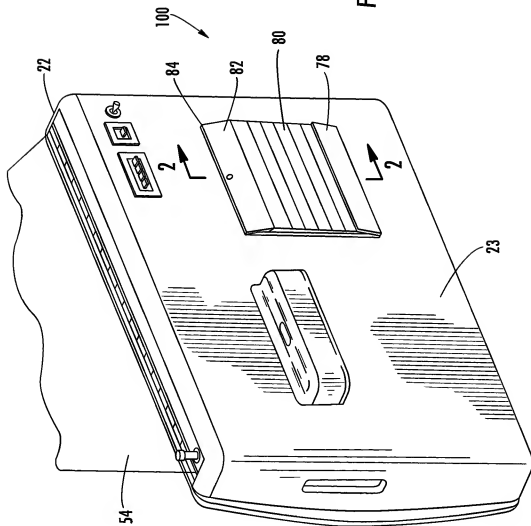


FIG. 5a - CHANGED  
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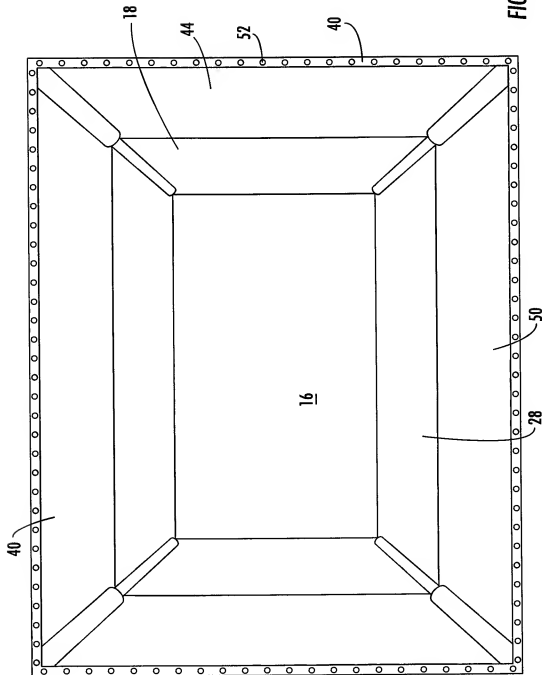


FIG. 5b - CHANGED  
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